

REMARKS

Issues not Related to Prior Art

Applicant has amended the specification, and provided a substitute specification herewith, to address the Examiner's comments relative to various trademarks. In general, Applicant has adopted the Examiner's suggestions relative to trademark usage.

With regard to the alleged informalities in claim 42, Applicant has cancelled this claim, thus rendering the objection moot.

With regard to the indefiniteness rejections, Applicant has amended the claims as suggested by the Examiner. It is respectfully requested that these amendments be entered, even though the present Office Action has been declared final, since no new searching is required. It is noted that the Examiner has indicated a particular interpretation "for the purpose of further examination" and the amendments merely confirm that interpretation.

Issues Related to Prior Art

The Examiner has rejected all of the claims as being anticipated by [Federov98]. It is respectfully submitted that the Examiner has failed to show that [Federov98] actually discloses the features the Examiner contends.

That is, Applicant respectfully reminds the Examiner of the requirement of 37 CFR 1.104(c)(2) which requires, in part, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." (emphasis added) In the present office action, the pertinence of the cited [Federov98] reference is clearly not apparent and, thus, the Examiner has not made a proper rejection.

For some of the features, the Examiner cites to portions of [Federov98] that are up to seventeen pages, without particularly alleging where these portions allegedly disclose a particular feature. For example, the Examiner contends that pages 325-341 of [Federov98] discloses:

wherein said do-start method determines
whether the custom action tag has a body, and
whether there is a need to process said body when said do-start method
determines that said custom action tag has a body.

The Examiner similarly points to the same portion of [Federov98], for the alleged disclosure of:
invoking said do-start method of said tag-handler object when invoking of said
do-start method determines there is a need to process said body of said custom action tag.

The Examiner also contends that both a thirteen page portion (pages 113-125) and a seven page portion (pages 125-131) of [Federov98] discloses the three features of:

processing, by said do-body method of said tag-handler object, said body of said
custom action tag, to translate said body from a first scripting language to platform

independent code that can be executed to perform actions intended by said custom action tag,

determining by said do-body method of said tag-handler object whether further processing is required to translate the body from a first scripting language to platform independent code that can be executed to perform the actions intended by said custom action tag when said processing has been performed by said do-body method of said tag-handler object,

and

repeating said processing, by said do-body method of said tag-handler object, when said do-body method of said tag-handler object determines that further processing is required.

The Examiner's allegations relative to others of the claims are similarly deficient. As just some examples, the features recited in claim 27 are alleged to also be disclosed at pages 113-125 of [Federov98], as are the features recited in claims 28, 29 (also citing the twenty four page portion of [Federov98] from pages 147-170) and 30 (also citing pages 147-170). The features recited in claim 31 are alleged to be disclosed at the twenty four page portion at pages 147-170 also.

Without specifically listing the number of pages recited against the features of each claim, it can be seen from the Office Action that multiple pages of the [Federov98] disclosure are cited against each of the claims, with many of these multiple page citations being simultaneously cited against multiple ones of the features.

Admittedly, the CFR section that requires the Examiner to cite a particular part of a reference "as nearly as practicable," and to clearly explain how that particular part of the reference applies to a specific claim, does not specify how to determine that a "reference is complex or shows or describes inventions other than that claimed by Applicant." Where as here, though the Examiner cites sections of a 991 page reference (page count according to Amazon.com), the reference can clearly be presumed to be "complex" and describing a lot of subject matter. Furthermore, where the cited sections themselves are up to twenty four pages and are each cited for multiple features, the Examiner clearly has not cited to a particular part of the reference "as nearly as practicable."

As a result, the Examiner's rejection based on [Federov98] is improper and should be withdrawn.

Request for Clarification

Applicant is not making a mere procedural argument in order to avoid addressing substantive issues. In fact, Applicant is very desirous of addressing the substantive issues of the Examiner's rejection, if there are any, and receiving a substantive, productive examination. Applicant thus respectfully requests the Examiner to more specifically indicate which portions of the [Federov98] reference are alleged to disclose the features recited in the claims or to withdraw the rejection if appropriate. Applicant further respectfully requests the Examiner to

concomitantly withdraw the finality of the rejections, in order to provide Applicant an adequate opportunity to respond to the Examiner's properly supported rejections.

In the alternative, if the Examiner determines that [Federov98] cannot properly support a rejection, then Applicant respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP

A handwritten signature in black ink, appearing to read 'Alan S. Hodes', enclosed within a large, stylized circular flourish.

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